

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLAND LAGASSE

Appeal 2006-2711
Application 10/662,935
Technology Center 3700

Decided: March 22, 2007

Before WILLIAM F. PATE, III, MURRIEL E. CRAWFORD, and JENNIFER D. BAHR, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Roland Lagasse (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1-6, 8-10, 12-14, and 16. Claims 7, 11, and 15 have been canceled. We have jurisdiction over this appeal under 35 U.S.C. § 6.

Appellant invented a joint for a shower arm arrangement. The joint allows two links to pivot relative to one another, but the joint itself is less likely to rotate than other joints in the prior art (Specification 1). Claim 13 is illustrative of the invention and reads as follows:

13. A pivot connection for a shower comprising:

a pair of links, said links being hollow and allowing passage of water through said links to a showerhead;

one of said links including an end wall, with a cup extending from said end wall, and a threaded member immovably fixed to said end wall and extending through and beyond said cup;

the other of said links including a hollow cylindrical member abutting said cup, with a nut attached to said threaded member on an opposed side of said hollow cylindrical member from said cup, with said threaded member being immovably fixed to said end wall; and

wherein the immovability of said threaded member is independent of the attachment of said nut.

The Examiner relies upon the following as evidence of unpatentability:

Smith	US 56,284	Jul. 10, 1866
Warren	US 557,735	Apr. 07, 1896
Campbell	US 628,692	Jul. 11, 1899
Wellington	US 1,297,763	Mar. 18, 1919
Judell	US 2,024,930	Dec. 17, 1935
Thulin	US 2,472,030	May 31, 1949

Appellant seeks review of the Examiner's rejections under 35 U.S.C. § 103(a) of claims 1, 2, 8, 13, and 16 as unpatentable over Thulin in view of Warren, claims 6 and 14 as unpatentable over Thulin in view of Warren and Smith, claim 3 as unpatentable over Thulin in view of Warren and Wellington, claim 4 as unpatentable over Thulin in view of Warren and Campbell, claim 5 as unpatentable over Thulin in view of Warren and Judell, and claims 9, 10, and 12 as unpatentable over Thulin in view of Warren, Judell, and Smith. The Examiner has withdrawn the rejection under 35 U.S.C. § 112, second paragraph (Answer 3).

The Examiner provides reasoning in support of the rejections in the Answer (mailed March 30, 2006). Appellant presents opposing arguments in the Brief (filed January 25, 2006) and Reply Brief (filed May 5, 2006).

OPINION

Appellant argues that the combination of Warren with Thulin, on which all of the Examiner's rejections are grounded, at least in part, is improper. Specifically, Appellant argues that Warren is so unrelated to the Thulin environment as to be non-analogous. Further, Appellant contends that, since there is no benefit or function described for the Warren structure, there is no suggestion to combine them (Br. 4).

Appellant does not argue claims 1, 2, 8, 13, and 16 separately from one another. Therefore, in accordance with 37 C.F.R. § 41.37(c)(1)(vii), we select claim 13 as the representative claim to decide the appeal of the rejection of claims 1, 2, 8, 13, and 16 as unpatentable over Thulin in view of Warren, with claims 1, 2, 8, and 16 standing or falling with claim 13.

Thulin discloses a bathtub shower bath appliance that can be coupled to the outlet spout of a faucet for directing a spray of water vertically downwardly and at various angles, through a short tubular arm 20, a knuckle joint, and a long tubular arm 27 from a spray nozzle 41, by adjustment of the angular position of the long tubular arm 27 (Thulin 1: 25-30, 2: 32-50, and 3: 25-29). As best illustrated in Fig. 7, the members 22, 25 of the knuckle joint are held together by “suitable fastening means,” such as a bolt 29 extending axially through the members with a nut 30 threaded onto the end of the bolt (Thulin 3: 1-5).

The Examiner finds that Thulin’s threaded member (bolt 29) is not immovably fixed to knuckle joint member 25 in such a way that its immovability is independent of the attachment of the nut 30, as called for in each of Appellant’s independent claims (Answer 4). Warren teaches, in a similar pivot joint, a threaded fastening member (stud 10) extending through the pivot joint and being integrally formed as one piece with one of the members of the pivot joint (Warren 1: 102-103 and Fig. 3). Warren’s pivot joint permits part 9 of racking-tube 7 to swing freely on its seat while also ensuring a tight joint (Warren 2: 1-3). The Examiner contends that it would have been obvious to one of ordinary skill in the art to immovably fix the threaded member of Thulin’s knuckle joint “in order to facilitate tightening of the connection” (Answer 4).

The first issue before us is whether, as argued by Appellant, Warren is so unrelated to the Thulin environment as to be non-analogous. Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s endeavor,

whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Clay*, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). In this instance, both Appellant and Warren deal with pivot joint couplings for permitting swinging or angular adjustment of one tubular member of a tubular conduit relative to another tubular member of the tubular conduit while still providing a tight joint between the two members (Specification 1-2 and 3; Warren 2: 1-3). Additionally, the tubular members and joints of both Warren and Appellant are used for directing liquid therethrough. We therefore conclude that Warren is reasonably pertinent to the particular problem with which Appellant is involved and is thus analogous to Appellant's invention.

Having established that Warren is analogous prior art, the next question is whether it would have been obvious to combine Warren with Thulin in the manner proposed by the Examiner. A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000).

Furthermore, like our reviewing court, “[w]e start from the self-evident proposition that mankind, in particular, inventors, strive to improve that which already exists.” Dystar Textilfarben GMBH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1363, 80 USPQ2d 1641, 1647 (Fed. Cir. Oct. 3, 2006) (*quoting Pro-Mold & Tool Co. Inc. v. Great Lakes*

Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996). As stated in *Dystar*,

an implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the “improvement” is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal – and even common-sensical – we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him capable of combining the prior art references.

Dystar, 464 F.3d at 1368, 80 USPQ2d at 1651.

While Warren does not expressly state the benefit of forming the stud 10 as one piece with the wall of part 8, the difficulty of tightening nuts onto freely rotatable through bolts, sometimes requiring one hand and tool to fix the bolt head against rotation while tightening the nut with a second hand and tool, was notoriously well known at the time of Appellant’s invention. The benefit of integrally forming the bolt or threaded member with one of the parts to be secured, such that the threaded member is fixed against rotation, is clearly not limited to the field of beer racking but, rather, is technology-independent, and would have been recognized as such by one of ordinary skill in the art. Moreover, one of ordinary skill in the art of shower arm arrangements would have readily understood how to form the threaded

member or bolt 29 of Thulin integrally with the knuckle joint member 25. We therefore conclude that it would have been obvious to modify Thulin as proposed by the Examiner, in order to facilitate tightening of the connection, to arrive at the subject matter recited in claim 13. The rejection of claim 13, and claims 1, 2, 8, and 16, which stand or fall with claim 13, as unpatentable over Thulin in view of Warren is sustained.

We also sustain the rejections of claim 3 as unpatentable over Thulin in view of Warren and Wellington, claim 4 as unpatentable over Thulin in view of Warren and Campbell, and claim 5 as unpatentable over Thulin in view of Warren and Judell, as Appellant has not challenged such apart from the rejection of claim 13 (*see In re Nielson*, 816 F.2d 1567, 1572, 2USPQ2d 1525, 1528 (Fed. Cir. 1987)).

Appellant separately argues the further combination of Smith with Thulin and Warren. The issue with regard to the rejections of claims 6 and 14 as unpatentable over Thulin in view of Warren and Smith and claims 9, 10, and 12 as unpatentable over Thulin in view of Warren, Judell, and Smith is whether Smith would have suggested providing a complementary boss on each of the knuckle joint members of Thulin rather than on just one of the two members.

The Examiner relies on Smith for its teaching of providing complementary ledges and bosses on both sections of the joint of a water-pipe. Specifically, as best seen in Fig. 2 of Smith, the mating face of one section of the joint is formed with an inner rim *e* (a ledge) and an annular flange *h* (a boss), the annular flange provided with an internal screw, and the outer surface of the other section is formed with an annular groove, the groove receiving a ring *d* provided with an external screw onto which the

flange *h* of the first section is securely threaded to secure the sections together. The ring has free circular movement within the groove to permit the oblique ends of the sections to be revolved relative to one another (Smith 1).

Appellant argues that the knuckle joints of Thulin and the joints of Smith are so different from one another both structurally and in their operation that there would have been no suggestion to combine the references as proposed by the Examiner to associate a boss and ledge with each of the knuckle joint sections (Br. 4-5). We agree.

The examiner may not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art (*Bausch & Lomb, Inc., v. Barnes Hind/Hydrocurve Inc.*, 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986)

The threaded flange and ring/groove arrangement of Smith is used to secure the two joint sections together as well as to permit oblique rotary motion between the two sections. Thulin, on the other hand, uses a separate threaded member and nut to secure the parts of the knuckle joint together. The separate threaded member and nut of Thulin would not be needed on a joint secured using the threaded flange and ring/groove arrangement taught by Smith. In short, Thulin and Smith disclose two different and mutually exclusive securement arrangements. Consequently, one of ordinary skill in the art would not have found suggestion to use them together or to pick and choose elements of one for use on the other.

In light of the above, we conclude that Appellant has demonstrated that the Examiner erred in rejecting claims 6 and 14 as unpatentable over Thulin in view of Warren and Smith and claims 9, 10, and 12 as unpatentable over Thulin in view of Warren, Judell, and Smith. The rejections cannot be sustained.

SUMMARY AND ORDER

The Examiner's decision is affirmed as to claims 1-5, 8, 13, and 16 and reversed as to claims 6, 9, 10, 12, and 14.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

JRG

Appeal 2006-2711
Application 10/662,935

CARLSON, GASKEY & OLDS, P.C.
400 WEST MAPLE ROAD
SUITE 350
BIRMINGHAM, MI 48009